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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/827,392

04/19/2004

Jonah Staw

89235

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34440

7590

08/19/2008

COLLEN IP
THE HOLYOKE MANHATTAN BUILDING
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EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/827,392	Applicant(s) STAW ET AL.	
	Examiner JAMES ZURITA	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's submission of 5 May 2008 has been entered.

Claims 1-23 are pending, of which claims 21-23 are withdrawn from prosecution as being directed to a non-elected invention.

Claims 1-20 will be examined.

Response to Arguments

On 5 May 2008, applicant amended claims 1-20.

For claim 1, objections to singular/plural are withdrawn in view of amendment.

For claims 4, 13, 19, 20 objections concerning antecedent basis are withdrawn in view of amendment.

Concerning coordinated, applicant argues

...specification discloses numerous considerations to be included in creating a system to coordinate but not match features on items. The specification is amended to title the section identified as "EXAMPLE SYSTEMS FOR CREATING..." to be titled "TYPICAL SYSTEM CONSIDERATIONS..." This amended title now better reflects what is included in the section. As disclosed the section is not an example but rather provides numerous issues and guidance for consideration when creating a coordination system as claimed.

Concerning traditional and non-traditional, Applicant quotes extensively from the MPEP and concludes that

Those skilled in the art fully understand what items are traditionally sold in pairs. The use of the phrase "traditionally sold in pairs" in the specification including Table 1 ensures that "those skilled in the art would understand what is claimed when the claim is read in light of the specification."

In response to the above, examples are not definitions.

...Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum,

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but in the context of the specification and drawings.”). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

- During prosecution, claims are given their broadest reasonable interpretation:

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. MPEP 2106.

The Examiner acknowledges that claims 4 and 5 differ in that Claim 4 refers to “category of items traditionally sold in pairs” and Claim 5 adds the limitation that the “items are also packaged for sale in quantities other than two”

Prior art rejections

Concerning the rejection of claim 1 under 35 USC 102(b), Applicant argues

Feld does not disclose

- selecting items to be coordinated but not matched;
- selecting a feature on those items;
- creating a system to coordinate the selected features on each item; and
- creating a minimum of two coordinated items based on the system

all of which are claimed in [amended] claim 1 of this application. Emphasis and notes added]

In response, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Applicant presents no separate arguments concerning the rejections of claims 7, 13 and 17 under 35 USC 103(a), but relies on patentability of claim 1.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term creating in Claim 1 renders the claims indefinite. Claim1 refers to creating a [series of steps] and to creating a set of physical items:

creating a system [of a series of steps]
creating a minimum of two...items based on the [series of steps].

However, the items already exist, since the items are selected in previous limitations of the claim. The physical items are described in other claims as "...items...are...[socks, earrings, etc.]..." The Examiner also notes that remaining claims pre-suppose the existence of the items that are initially selected, since applicant refers to the items as items chosen from a category of items traditionally sold in pairs and packaged in non-traditional quantities.

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As to the series of steps claimed, claim 1 appears to comprise (a) selecting items and (b) selecting a feature of [each?] item. Claim 3 adds (c) considering characteristics of color, etc., claim 2 adds (d) considering age, etc.

For purposes of examination the limitations are interpreted to refer to one or more steps that are repeated to produce a result.

Coordinated, not-matched and their derivatives

In claim 1, the terms coordinated, not-matched [and their derivatives and combinations] appear to be descriptive material, merely describing inferential activities that are not involved in an active sense and are not positively recited. For example, Claim 1 refers, in part, to

selecting items [...label 1: to be coordinated but not matched];
selecting a feature on the items [...label 1: to be coordinated but not matched];
creating a system [a series of steps] [...label 2: to coordinate but not match] the selected feature on each item; and
creating a minimum of **two** [...label 3: coordinated...] **items** based on the [series of steps].

For purposes of examination the limitations are interpreted to refer to selecting items based on attributes.

traditional and non-traditional

In claims 4, 14, 18, 19 and 20, the terms traditional and non-traditional render the claims indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear how one determines what is *traditional* and *non-traditional* in order to avoid infringement. In

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the absence of an explicit definition, the terms traditional, non-traditional [and derivatives] are given their broadest reasonable interpretation to include any aspect of cultural continuity in social attitudes, customs, and institutions. MERRIAM WEBSTER Collegiate Dictionary. Prior art will be interpreted as reading on traditional, non-traditional where prior art discloses the action as occurring on any quantity of a product.

parts and pieces

Claims 8-10 refer to items with multiple parts while claims 11-14 refer to items with multiple pieces. The specifications and drawings appear to use the terms as synonyms. The terms will be interpreted as synonyms.

Items and products

Claims 11, 15, 19 and 20 refer to products, other claims refer to items. The specifications and drawings appear to use the terms as synonyms. The terms will be interpreted as synonyms.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6, 8-12, 14-16, 18-20, as interpreted, are rejected under 35U.S.C. 102(b) as being anticipated by Feld et al., US PG-PUB 20010026272, filed 26 February 2001 and published October 2001.

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As per claim 1, Feld discloses method(s) for coordinating but not matching items comprising:

Selecting items to be coordinated but not matched. See, for example, Feld, at least paragraph 0054.

Selecting a feature on the items to be coordinated but not matched. See, for example, Feld, at least paragraph 0045;

Creating a system to coordinate but not match the selected feature on each item. See, for example, Feld, at least Figs. 5, 6 and 10 for series of steps.

Creating a minimum of two coordinated items based on the system. See, for example, Feld, paragraph 0012.

As per claim 3, Feld discloses considering the characteristics of color, patterns, shapes and size for coordination. See, for example, Feld, at least color (paragraph 0039), patterns (paragraph 0013), shapes (paragraph 0002) and size (paragraph 0039).

As per claim 2, Feld discloses considering age, sex and culture. Feld, paragraph 0032 and 0035.

As per claim 4, Feld discloses that items selected are chosen from a category of items traditionally sold in pairs. See, for example, Feld, socks, as in paragraph 0032).

As per claim 5, Feld discloses that items are packaged for sale in quantities other than two. See, for example, Feld, at least paragraph 0002.

As per claim 6, Feld discloses that the items are socks. See, for example, Feld, at least paragraph 0032.

As per claim 8, Feld discloses that the items selected are chosen from a category of items with multiple parts. See, for example, Feld, at least eyeglasses, as in paragraph 0032; see also Fig. 11.

As per claim 9, Feld discloses that the items are eyeglasses. See, for example, Feld, at least paragraph 0032.

As per claim 10, Feld discloses that the items are sweatpants. See, for example, Feld, at least Paragraph 0032.

As per claim 11, Feld discloses that the items selected are chosen from a category of products with multiple pieces. See, for example, Feld, at least Fig. 11 and related text.

As per claim 12, Feld discloses the items are pajama tops, bottoms, and slippers. See, for example, Feld, at least Paragraph 0032, lingerie, underclothing.

Claim 14 is rejected on the same grounds as claim 5.

As per claim 15, Feld discloses that the items selected is are chosen from a category of products matched within a group. See, for example, Feld, Fig. 1 and related text. See also paragraph 0054.

As per claim 16, Feld discloses that the items used in kitchens are selected. See, for example, Feld, at least paragraphs 0008, 0032 and other references to furniture coverings, curtains, etc.

Claim 18 is rejected on the same grounds as claim 5.

As per claim 19, Feld discloses that items selected are chosen from a category of items traditionally sold in pairs wherein the products have multiple unconnected pieces. See, for example, Feld, at least paragraph 0032.

As per claim 20, Feld discloses that items selected are chosen from a category of items traditionally sold in pairs, wherein the products have multiple physically connected pieces. Feld, see, for example, at least Fig. 11 and related text.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 7, as interpreted, is rejected under 35 U.S.C. 103(a) as being unpatentable over Feld.

As per claim 7, Feld discloses does not specifically disclose that hat the items are earrings. Feld discloses that articles may include accessories such as belts, jewelry. It would have been obvious to one of ordinary skill in the art at the time the invention was made to expand Feld to disclose that hat the items are earrings because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feld in view of Berger, US 6,414,693.

As per claim 13, Feld does not specifically disclose that a luggage set is selected. This is disclosed by Berger, Col. 1, lines 12-33. It would have been obvious to

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one of ordinary skill in the art at the time the invention was made to combine Feld and Berger to disclose that a product is a luggage set because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feld in view of Marx et al. (PG-PUB 2003/0104148A1).

As per claim 17, Feld does not specifically disclose that the items selected are clothing items for members of a team. This is disclosed by Marx, paragraph 0008. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Feld and Marx to disclose that products are clothing for team members because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Point taken: This season's round shoes will flatter your feet. But beware of piggy legs; [National Edition], *Mireille Silcoff*. National Post. Don Mills, Ont.: Mar 8, 2003. pg. FA.10, 3 pages, downloaded from ProQuest Direct on the Internet on 16 August 2008.

Contemporary style, ethnic fabric mixed | Fashion Focus; [1,2,3,4,5,6 Edition], *Lucretia Steiger*. The San Diego Union. San Diego, Calif.: Oct 12, 1985. pg. C.2, 3 pages, downloaded from ProQuest Direct on the Internet on 16 August 2008.

Willi Smith put whimsy in fashion:[FINAL Edition] , Elizabeth Sporkin. USA TODAY (pre-1997 Fulltext). McLean, Va.:Apr 20, 1987. p. 04D, 3 pages, downloaded from ProQuest Direct on the Internet on 16 August 2008.

FootTraffic web site. 4 pages, downloaded from the Internet on 11 February 2008.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
Primary Examiner
Art Unit 3625
17 August 2008